

Application No. 10/707,182
Amendment dated September 29, 2005
Reply to Office Action of June 29, 2005

Docket No.: 60680-1722

REMARKS

The Office Action dated June 29, 2005 has been carefully reviewed and this response is submitted in consequence thereof. No claims have been amended, added, canceled, or withdrawn. Claims 1-8 remain pending. Applicants request reconsideration of the pending claims for allowance in view of the following remarks and arguments.

35 U.S.C. §103

Claim rejections using Sakurai et al. in view of Paoluccio

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,790,287 to *Sakurai et al.* in view of U.S. Patent No. 4,616,620 to *Paoluccio*. Applicants respectfully traverse the rejections.

Claims 1 and 5 recite, among other limitations, "a basket sealingly mounted to a valve cover of an engine...." Contrary to the Examiner's assertions, *Sakurai et al.* does not disclose or teach a basket sealingly mounted to a valve cover of an engine.

Sakurai et al. discloses a separator (55) that is contained within a crankcase chamber of a cylinder block. The examiner asserts that the separator (55) of *Sakurai et al.* is for an internal combustion engine "with a basket (57) sealingly mounted to a valve cover (53) of an engine." Contrary to the examiner's assertion, *Sakurai et al.* discloses that "a separator...is contained within the upper crankcase chamber so that the lubricant may be returned to the crankcase from the separator." (Col. 1, lines 49-53) As recognized by one of ordinary skill in the art, the crankcase chamber of an engine is located within the cylinder block of the engine. Accordingly, *Sakurai et al.* discloses the separator (55) being mounted to the top wall (53) of cylinder block (14). Thus, contrary to the examiner's assertion, the so-called "valve cover (53)" in *Sakurai et al.*, is not a valve cover as would be recognized by one of ordinary skill in the art. Rather, as discussed above, the so-called "valve cover (53)" is actually the top wall of the cylinder block (14). Thus, there is no teaching by *Sakurai et al.* of an oil separator with a basket sealingly mounted to a valve cover of an engine, as recited by claim 1.

Application No. 10/707,182
Amendment dated September 29, 2005
Reply to Office Action of June 29, 2005

Docket No.: 60680-1722

Nor does Paoluccio do anything to cure the deficiencies of Sakurai et al. Indeed, Paoluccio teaches a contamination control apparatus configured to prevent ambient air and moisture from entering an engine crankcase. The apparatus includes, among other things, "a desiccant dryer 28 that constantly removes any moisture from the air within the interior of the engine and oil distribution system whenever the engine is off." (See Column 3, lns. 45-48) As understood by those skilled in the art, a desiccant is not used to separate oil particles from blow-by gas that occurs during operation of an internal combustion engine but rather is used as a drying agent to remove moisture from air.

Two criteria are used for determining analogous art: 1) whether the art is from the same field of endeavor, regardless of the problem addressed; and 2) if the reference is not within the field of the inventor's endeavor, whether it is still reasonably pertinent to the particular problems with which the inventor is involved. In re Oetiker, 977 F.2d 1443, 1443 (Fed. Cir. 1992). As briefly described above, Paolucci teaches a desiccant dryer 28 to remove moisture from the air within the interior of the engine and oil distribution system when the engine is off. In contrast, claim 1 describes an oil separator for an internal combustion engine that is operable to remove oil particles from blow-by gas. It is appreciated that blow by gas occurs when gas leaks from the combustion chamber into the crank case through gaps between the piston and cylinder during compression and explosion strokes, i.e., engine running. Clearly, one of ordinary skill in the art would not be motivated to combine the teachings of references which endeavor to solve different problems, i.e., oil separation from blow-by gas versus contamination control/moisture removal within an engine, that occur under different circumstances, i.e., engine running versus engine off. If the reference has a different purpose, the inventor would have less motivation or occasion to consider it. In re Clay, 966 F.2d 656, (Fed. Cir. 1992). It is appreciated that a reference which teaches an engine contamination control apparatus that includes a desiccant dryer which may be mounted to a valve cover does not suggests an oil separator configured to separate oil particles from blow-by gas wherein the oil separator is mounted to a valve cover. Accordingly, claims 1 and 5, as well as their dependent claims, are patentable over the prior art. As such, Applicants respectfully request that this rejection be withdrawn.

Application No. 10/707,182
Amendment dated September 29, 2005
Reply to Office Action of June 29, 2005

Docket No.: 60680-1722

CONCLUSION

In view of the above remarks and arguments, Applicants believe the pending application is in condition for allowance. Favorable reconsideration and early allowance are earnestly solicited.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1722 from which the undersigned is authorized to draw.

Dated: September 29, 2005

Respectfully submitted,

By: 
Kristin L. Murphy

Registration No.: 41,212
Lionel D. Anderson, Reg. No.: 50,571
RADER, FISHMAN & GRAUER PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, Michigan 48304
(248) 594-0652
Attorneys for Applicant

R0280414.DOC

PTO/SB/97 (09-04)
Approved for use through 07/31/2006, OMB 0651-0031
U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

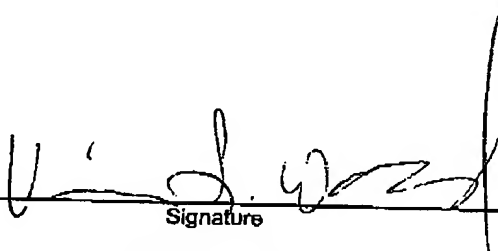
Application No. (if known): 10/707,182

Attorney Docket No.: 60680-1722

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office.

on September 29, 2005
Date



Signature

Victoria L. Wood

Typed or printed name of person signing Certificate

Registration Number, if applicable

(248) 593-3326
Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Amendment (5 pages)